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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/655,558

09/04/2003

Zaida Pericas

60027.0200USU1/BS030092

6412

39262

7590

03/05/2009

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EXAMINER

MAGUIRE, LINDSAY M

ART UNIT

PAPER NUMBER

3692

MAIL DATE

DELIVERY MODE

03/05/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/655,558	Applicant(s) PERICAS ET AL.	
	Examiner LINDSAY M. MAGUIRE	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 11-14, 16, 17, 19 and 23-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11-14, 16, 17, 19 and 23-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Final action is in response to the application filed on September 4, 2003, the preliminary amendment filed on April 27, 2006 in which claims 7-9, 15, 18, 20, and 21 were cancelled and claims 30 and 31 were added, the amendments filed on April 3, 2008, the Request for Continued Examination filed on October 7, 2008, and the amendments filed on January 20, 2008.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble of claim 17 sets forth a system claim. Line 4 of the claim further sets forth that the claim is a system claim. However, it is unclear how the system of claim 17 functions when the "system" is only recited in its broadest sense. Specifically there is no specific structure set forth delineating exactly what accomplishes the steps of the claim. It is unclear if applicant is seeking to claim every possible system that could perform the steps of claim 17, or if applicant is seeking to claim a specific system. Appropriate correction is required. It is noted that although the claim recites, "a computer executable system" in line 1, it does not actually recite any structure within the

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body of the claim. Therefore, the claim fails to breathe life and breath into computer executable system as set forth in the preamble.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6, 11-14, 16, 19, and 23-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A claimed process is eligible for patent protection under 35 U.S.C. § 101 if:

"(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See Benson, 409 U.S. at 70 ('Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines. '); Diehr, 450 U.S. at 192 (holding that use of mathematical formula in process 'transforming or reducing an article to a different state or thing' constitutes patent-eligible subject matter); see also Flook, 437 U.S. at 589 n.9 ('An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing' '); Cochrane v. Deener, 94 U.S. 780, 788 (1876) ('A process is...an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.').⁷ A claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to

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transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article.” (*In re Bilski*, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008))

Claims 1-6, 11-14, 16, 19, and 23-31 are not tied to a particular machine or apparatus nor do they transform a particular article into a different state or thing; therefore, claims 1-6, 11-14, 16, 19, and 23-31 are non-statutory under § 101. It is noted that although the independent claims recite, "executed on one or more computer systems" they do not actually recite any structure within the body of the claim. Therefore, the claim fails to breathe life and breath into computer system as set forth in the preamble.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 11-14, 16, 17, 19, and 23-31 rejected, inasmuch as the claims can best be understood given the 35 USC 112 and 101 rejections (as advanced above), under 35 U.S.C. 103(a) as being unpatentable over U.S. PGPub. No. 2001/0056362 (Hanagan et al. '362), In view of "Cingular Offers Rollover Minutes" (Cingular).

Regarding claims 1-6 and 30, Hanagan et al. '362 discloses a method of integrating billing, services management, and revenue sharing between a wireless telecommunications carrier and a wireline telecommunications carrier executed on one or more computers, comprising; provisioning a call unit sharing plan allowing a user to charge units of wireless usage at a wireless carrier and traits of wireline usage to one calling plan (paragraph [0050]); receiving wireless usage at the wireless carrier (paragraph [0078]); receiving wireline usage at a wireline usage rating platform (paragraph [0078]); routing the wireless usage to the wireline usage rating platform (paragraph [0078]); and if any of the wireless or wireline usage requires a billing charge, charging may of the wireless or wireline usage to the call unit sharing plan (paragraph [0079]); and settling revenue associated with the single periodic bill between the wireless carrier and the wireline carrier by apportioning an amount of the revenue associated with wireless services during a billing cycle associated with the single periodic bill to the wireless carrier; and apportioning an amount of the revenue associated with wireline services during the billing cycle associated with the single periodic bill to the wireline carrier (paragraphs [0129 – 0136, 0160, & 0196]).

Additionally, Hanagan et al. '362 disclose preparing a single periodic bill showing charges to the call unit sharing plan associated with the wireless and wireline usage charged to the call unit sharing plan (paragraph [0079]); and prior to charging any of the wireless or wireline usage to the call unit sharing plan, rating the wireless and wireline usage at the wireline usage rating platform to determine whether any of the wireless or wireline usage must be charged to the call unit sharing plan (paragraph [0079 – 0080]).

Furthermore, Hanagan et al. '362 disclose determining whether any of the wireless or wireline usage is associated with calling types requiring no charge (paragraphs [0089 – 0097]); whereby if any of the wireless or wireline usage is associated with calling types requiring no charge, designating the any of the wireless or wireline usage associated as requiring no charge (paragraphs [0089 – 0097]); whereby at least some of the wireless usage requires no charge because a wireless call associated with the at least some of the wireless usage requiring no charge was made during a free call period or a different rate call period (paragraphs [0128 – 0140]); and whereby at least some of the wireless usage requires no charge because a wireless call associated with the at least some of the wireless usage requiring no charge was made from a wireless phone of a user to a wireline home phone of the user (paragraphs [0089-0097]).

While Hanagan et al. '362 does not explicitly disclose that the method is between a wireless telecommunications carrier and a disparate wireline telecommunications carrier, this is not considered to be a patently distinct function. Specifically, it is unclear how the structure used to perform the actions of the method with one company would differ from the structure used to perform the actions of the method with two different companies.

“As to the rejection of the claims on the prior art references, we do not agree with the appellant that such structural limitations as are not disclosed by the references should be given patentable weight. This argument is applicable to claims drawn to structure and not claims drawn to a method. **To be entitled to**

such weight in method claims, the recited **structural limitations** therein **must affect the method** in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, in our opinion, is the case here.”
Ex parte Pfeiffer, 135 USPQ 31 (BdPatApp&Int 1961)”

Furthermore, it is considered to be obvious that since the method of Hanagan et al. '362 is performed for a single company, that it could be performed for separate companies (please see MPEP 2144.04 (V) “Making Integral, making separable”).

Hanagan et al. '362 disclose the method substantially as claimed, as advanced above, with the exception of requiring receiving a rollover matrix indicating a number of units of call usage that are available for rolling over to a subsequent usage period; rolling over to the subsequent usage period the number of units of call usage that are available for rolling over (claim 1, lines 9-12). Cingular discloses providing a user with rollover minutes that are unused minutes that can be added to their next month's minute allotment (paragraph 6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Hanagan et al. '362, in view of Cingular, for the basic reason of allowing users to keep their unused minutes for a time when they will need them (paragraphs 6-8).

With respect to claims 11-14 and 16, Hanagan et al. '362 disclose a method for synchronizing services between a first and second telecommunications services carrier

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executed on one or more computers, comprising: receiving a services order at a first services ordering platform of the first telecommunications services carrier requiring services changes that affect the second telecommunication services carrier (paragraphs [0079, 0080, & 0182-0186]); notifying the second telecommunications services carrier to provide the services order to the second telecommunications services carrier (paragraphs 0143, 0144, & 0168-0172)]. Additionally, Hanagan et al. '362 disclose ensuring that subscriber services at the first telecommunications services carrier are synchronized with subscriber services at the second telecommunications services carrier for any subscriber services affecting both the first and second telecommunications services carriers (paragraph [0105 – 0109]); ensuring that no subscriber services changes are made at the first telecommunications services carrier affecting the second telecommunications services carrier if a responsive services change is not made at the second telecommunications services carrier (paragraphs [0125, 0126, & 0138 – 0140]); and if a services change is made at the first telecommunications services carrier affecting the second telecommunications services carrier without making a required responsive services change at the second telecommunications services carrier, notifying the second telecommunications carrier of the services change at the first telecommunications services carrier (paragraphs [0168 –0172]). Furthermore, Hanagan et al. '362 disclose, sending an integrated fulfillment notification to any subscriber making services changes with either the first telecommunications services carrier or the second telecommunications services carrier where the services changes affect both the first telecommunications services carrier

and the second telecommunications services carrier (paragraphs [0082 & 0168 – 0172]).

While Hanagan et al. '362 does not explicitly disclose that the method is between a wireless telecommunications carrier and a disparate wireline telecommunications carrier, this is not considered to be a patently distinct function. Specifically, it is unclear how the structure used to perform the actions of the method with one company would differ from the structure used to perform the actions of the method with two different companies.

““As to the rejection of the claims on the prior art references, we do not agree with the appellant that such structural limitations as are not disclosed by the references should be given patentable weight. This argument is applicable to claims drawn to structure and not claims drawn to a method. **To be entitled to such weight in method claims**, the recited **structural limitations** therein **must affect the method** in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, in our opinion, is the case here.”
Ex parte Pfeiffer, 135 USPQ 31 (BdPatApp&Int 1961)”

Furthermore, it is considered to be obvious that since the method of Hanagan et al. '362 is performed for a single company, that it could be performed for separate companies (please see MPEP 2144.04 (V) “Making Integral, making separable”).

Hanagan et al. '362 discloses the method substantially as claimed, as advanced above, with the exception of requiring on a periodic basis, updating a customer affiliate subscriber information database in a business services platform the service changes that affect the second telecommunications services carrier; and on a periodic basis, synchronizing batch files passed from a subscriber data system of the first telecommunications services carrier to the customer affiliated subscriber information database to ensure the customer affiliated subscriber information database has complete information related to a subscriber to the first telecommunications services carrier and the second telecommunications services carrier (claim 11, lines 11-18). However, Hanagan et al. '362 does disclose various forms of updating changes and matching changes are disclosed (in at least paragraphs [0082, 0094, 0172, 0181, 0192, 0213, 0217, 0219, 0230, 0271, 0272, & 0335]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to update and synchronize subscriber information in the database on a periodic basis, for the basic reason to keep files up to date, and the same across the board.

In regards to claim 17, Hanagan et al. '362 disclose a computer executable system for integrating billing, services management, and revenue sharing between a wireless telecommunications carrier and a wireline telecommunications carrier, comprising; a wireless carder billing system operative to receive wireless call usage associated with wireless calls made via the wireless carrier (paragraph [0050]); to route the wireless call usage to a call usage rating platform at the wireline carrier (paragraph

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[0078]); the call usage rating platform at the wireline carrier operative to receive wireline call usage associated with wireline calls made via the wireline carrier (paragraph [0078]); to charge any of the wireless or wireline call usage to a subscriber call unit sharing plan when any of the wireless or wireline call usage requires a billing charge (paragraph [0078]); to route rated call usage reformation for all wireless and wireline call usage requiring billing under the subscriber call unit sharing plan to a wireline carrier billing system (paragraphs [0078-0080]); the wireline carrier billing system operative to prepare a single periodic bill showing charges to the subscriber call unit sharing plan associated with the wireless and wireline call usage charged to the call unit sharing plan (paragraphs [0078-0080]); and to settle revenue associated with the single periodic bill between the wireless carrier and the wireline carrier by apportioning an amount of the revenue associated with wireless services during a billing cycle associated with the single periodic bill to the wireless carrier; and apportioning an amount of the revenue associated with wireline services during the billing cycle associated with the single periodic bill to the wireline carrier (paragraphs [0129 – 0136, 0160, & 0196]).

While Hanagan et al. '362 does not explicitly disclose that the system is between a wireless telecommunications carrier and a disparate wireline telecommunications carrier, this is not considered to be a patently distinct function. Specifically, it is unclear how the structure used to perform the actions of the system with one company would differ from the structure used to perform the actions of the system with two different companies. Furthermore, it is considered to be obvious that since the method of

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Hanagan et al. '362 is performed for a single company, that it could be performed for separate companies (please see MPEP 2144.04 (V) "Making Integral, making separable").

Hanagan et al. '362 disclose the system substantially as claimed, as advanced above, with the exception of requiring a rollover management system operative to generate a rollover matrix indicating a number of units of call usage that are available for rolling over to a subsequent usage period; to roll over to the subsequent usage period the number of units of call usage that are available for rolling over, and to indicate the number of units of call usage that have been rolled over to the subsequent usage period (claim 17, lines 17-21 & 26-27). Cingular discloses providing a user with rollover minutes that are unused minutes that can be added to their next month's minute allotment (paragraph 6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Hanagan et al. '362, in view of Cingular, for the basic reason of allowing users to keep their unused minutes for a time when they will need them (paragraphs 6-8). Additionally, it would be obvious to one of ordinary skill in the art to display, on the users bill for example, how many minutes are leftover, since it is already standard to show the minutes used, for the basic reason of allowing users to see how many of their minutes are going to rollover into the next usage period.

Regarding claims 19 and 31, Hanagan et al. '362 disclose a method of integrating billing management and revenue sharing between a wireless telecommunications carrier and a wireline telecommunications carrier executed on one or more computers, comprising; provisioning a call unit sharing plan allowing a user to charge units of wireless usage at a wireless carrier and units of wireline usage to one calling plan (paragraph [0050]); receiving wireless usage at the wireless carrier; receiving wireline usage at a wireline usage rating platform; routing the wireless usage to the wireline usage rating platform (paragraph [0078]); rating the wireless and wireline usage at the wireline usage rating platform to determine whether any of the wireless or wireline usage must be charged to the call unit sharing plan when any of the wireless or wireline usage requires a billing charge, charging the any of the wireless or wireline usage to the call unit sharing plan (paragraphs [0078-0080]); and preparing a single periodic bill showing charges to the call unit sharing plan associated with the wireless and wireline usage charged to the call unit sharing plan (paragraph [0079]); and settling revenue associated with the single periodic bill between the wireless carrier and the wireline carrier by apportioning an amount of the revenue associated with wireless services during a billing cycle associated with the single periodic bill to the wireless carrier; and apportioning an amount of the revenue associated with wireline services during the billing cycle associated with the single periodic bill to the wireline carrier (paragraphs [0129 – 0136, 0160, & 0196]). Additionally, Hanagan et al. '362 disclose that if any of the wireless usage comprises a wireless call from a wireless phone of a

user to a wireline home phone of the user, designating the wireless or wireline usage associated with the wireless call as requiring no charge (paragraphs 0089-0097]).

While Hanagan et al. '362 does not explicitly disclose that the method is between a wireless telecommunications carrier and a disparate wireline telecommunications carrier, this is not considered to be a patently distinct function. Specifically, it is unclear how the structure used to perform the actions of the method with one company would differ from the structure used to perform the actions of the method with two different companies.

“As to the rejection of the claims on the prior art references, we do not agree with the appellant that such structural limitations as are not disclosed by the references should be given patentable weight. This argument is applicable to claims drawn to structure and not claims drawn to a method. **To be entitled to such weight in method claims**, the recited **structural limitations** therein **must affect the method** in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, in our opinion, is the case here.”
Ex parte Pfeiffer, 135 USPQ 31 (BdPatApp&Int 1961)”

Furthermore, it is considered to be obvious that since the method of Hanagan et al. '362 is performed for a single company, that it could be performed for separate companies (please see MPEP 2144.04 (V) “Making Integral, making separable”).

Hanagan et al. '362 disclose the method substantially as claimed, as advanced above, with the exception of requiring receiving a rollover matrix indicating a number of units of call usage that are available for rolling over to a subsequent usage period; rolling over to the subsequent usage period the number of units of call usage that are available for rolling over, and showing the number of units of call usage that have been rolled over to the subsequent usage period (claim 19, lines 12-15 & 18). Cingular discloses providing a user with rollover minutes that are unused minutes that can be added to their next month's minute allotment (paragraph 6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Hanagan et al. '362, in view of Cingular, for the basic reason of allowing users to keep their unused minutes for a time when they will need them (paragraphs 6-8). Additionally, it would be obvious to one of ordinary skill in the art to display, on the users bill for example, how many minutes are leftover, since it is already standard to show the minutes used, for the basic reason of allowing users to see how many of their minutes are going to rollover into the next usage period.

With respect to claims 23-25, Hanagan et al. '362 disclose a method of integrating billing management between a plurality of disparate telecommunications services systems executed on one or more computers, comprising; receiving first call usage associated with calls transacted via a first services system (paragraphs [0050 & 0078]); receiving second call usage associated with calls transacted via a second services system (paragraph [0078]); routing the first call usage and the second call

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usage to one or more call usage rating platforms, at the one or more call usage rating platforms, determining billing information associated with each of the first and second call usages (paragraph [0078]); routing billing information associated with each of the first and second call usages to a billing system (paragraphs [0078-0079]); and preparing a single periodic bill showing charges associated with the first and second call usages (paragraph [0079]). Additionally, Hanagan et al. '362 disclose that routing the first call usage and the second call usage to the one or more call usage rating platforms includes routing the first call usage to a first call usage rating platform and routing the second call usage to a second call usage rating platform (paragraphs [0078-0080]; Figure 6); and whereby routing the first call usage and the second call usage to the one or more call usage rating platforms includes routing the first call usage and the second call usage to a single call usage rating platform at one of the first or second services systems (paragraphs [0078-0080]; Figure 6).

While Hanagan et al. '362 does not explicitly disclose that the method is between a wireless telecommunications carrier and a disparate wireline telecommunications carrier, this is not considered to be a patently distinct function. Specifically, it is unclear how the structure used to perform the actions of the method with one company would differ from the structure used to perform the actions of the method with two different companies.

“As to the rejection of the claims on the prior art references, we do not agree with the appellant that such structural limitations as are not disclosed by the references should be given patentable weight. This argument is applicable to claims drawn to structure and not claims drawn to a method. **To be entitled to such weight in method claims**, the recited **structural limitations** therein **must affect the method** in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, in our opinion, is the case here.”
Ex parte Pfeiffer, 135 USPQ 31 (BdPatApp&Int 1961)”

Furthermore, it is considered to be obvious that since the method of Hanagan et al. '362 is performed for a single company, that it could be performed for separate companies (please see MPEP 2144.04 (V) “Making Integral, making separable”).

Hanagan et al. '362 disclose the method substantially as claimed, as advanced above, with the exception of requiring receiving a rollover matrix indicating a number of units of call usage that are available for rolling over to a subsequent usage period; rolling over to the subsequent usage period the number of units of call usage that are available for rolling over, and showing the number of units of call usage that have been rolled over to the subsequent usage period (claim 23, lines 12-15 &17-18). Cingular discloses providing a user with rollover minutes that are unused minutes that can be added to their next month's minute allotment (paragraph 6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

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modify the method of Hanagan et al. '362, in view of Cingular, for the basic reason of allowing users to keep their unused minutes for a time when they will need them (paragraphs 6-8). Additionally, it would be obvious to one of ordinary skill in the art to display, on the users bill for example, how many minutes are leftover, since it is already standard to show the minutes used, for the basic reason of allowing users to see how many of their minutes are going to rollover into the next usage period.

Regarding claims 26-28, Hanagan et al. '362 disclose a method of integrating billing and services management between a wireless telecommunications carrier and a wireline telecommunications carrier executed on one or more computers, comprising; provisioning a call unit sharing plan allowing a user to charge units of wireless usage at a wireless carrier and units of wireline usage to one calling plan (paragraph [0050]); receiving wireless usage at a wireless carrier (paragraph [0078]); receiving wireline usage at a wireline usage rating platform (paragraph [0078]); receiving the wireless usage at the wireline usage rating platform (paragraphs [0078-0080]); add when any of the wireless or wireline usage requires a billing charge, charging any of the wireless or wireline usage to the call unit sharing plan (paragraph [0079]). Additionally, Hanagan et al. '362 disclose preparing a single periodic bill showing charges to the call unit sharing plan associated with the wireless and wireline usage charged to the call unit-sharing plan (paragraph [0079]); prior to charging any of the wireless or wireline usage to the call unit sharing plan: rating each wireless and wireline usage at the wireline usage rating platform to determine whether any usage must be charged to the call unit sharing

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plan: determining whether any wireless usage or wireline usage is associated with calling types requiring no charge; and in response to any wireless usage or wireline usage being associated with calling types requiring no charge, designating the any wireless usage or wireline usage requiring no charge as requiring no charge (paragraphs [0079, 0080, & 0089 – 0097]).

While Hanagan et al. '362 does not explicitly disclose that the method is between a wireless telecommunications carrier and a disparate wireline telecommunications carrier, this is not considered to be a patently distinct function. Specifically, it is unclear how the structure used to perform the actions of the method with one company would differ from the structure used to perform the actions of the method with two different companies.

“As to the rejection of the claims on the prior art references, we do not agree with the appellant that such structural limitations as are not disclosed by the references should be given patentable weight. This argument is applicable to claims drawn to structure and not claims drawn to a method. **To be entitled to such weight in method claims**, the recited **structural limitations** therein **must affect the method** in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, in our opinion, is the case here.”
Ex parte Pfeiffer, 135 USPQ 31 (BdPatApp&Int 1961)”

Furthermore, it is considered to be obvious that since the method of Hanagan et al. '362 is performed for a single company, that it could be performed for separate companies (please see MPEP 2144.04 (V) "Making Integral, making separable").

Hanagan et al. '362 disclose the method substantially as claimed, as advanced above, with the exception of requiring receiving a rollover matrix indicating a number of units of call usage that are available for rolling over to a subsequent usage period; rolling over to the subsequent usage period the number of units of call usage that are available for rolling over (claim 26, lines 9-12). Cingular discloses providing a user with rollover minutes that are unused minutes that can be added to their next month's minute allotment (paragraph 6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Hanagan et al. '362, in view of Cingular, for the basic reason of allowing users to keep their unused minutes for a time when they will need them (paragraphs 6-8).

In regards to claim 29, Hanagan et al. '362 disclose a method of integrating billing and services management between a wireless telecommunications carrier and a wireline telecommunications carrier executed on one or more computers, comprising; provisioning a call unit sharing plan allowing a user to charge traits of wireless usage at a wireless carrier and units of wireline usage to one calling plan (paragraph [0050]); receiving wireline call usage at a wireline rating platform (paragraph [0078]); receiving wireless call usage at the wireline rating platform (paragraph [0078]); when any of the

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wireless or wireline call usage requires a billing charge, charging the any of the wireless or wireline call usage requiring a billing charge to the call unit sharing plan (paragraph [0079]); and preparing a single periodic bill showing charges to the call unit sharing plan associated with the wireless and wireline call usage charged to the call unit sharing plan (paragraph [0079]).

While Hanagan et al. '362 does not explicitly disclose that the method is between a wireless telecommunications carrier and a disparate wireline telecommunications carrier, this is not considered to be a patently distinct function. Specifically, it is unclear how the structure used to perform the actions of the method with one company would differ from the structure used to perform the actions of the method with two different companies.

“As to the rejection of the claims on the prior art references, we do not agree with the appellant that such structural limitations as are not disclosed by the references should be given patentable weight. This argument is applicable to claims drawn to structure and not claims drawn to a method. **To be entitled to such weight in method claims**, the recited **structural limitations** therein **must affect the method** in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, in our opinion, is the case here.”

Ex parte Pfeiffer, 135 USPQ 31 (BdPatApp&Int 1961)”

Furthermore, it is considered to be obvious that since the method of Hanagan et al. '362 is performed for a single company, that it could be performed for separate companies (please see MPEP 2144.04 (V) "Making Integral, making separable").

Hanagan et al. '362 disclose the method substantially as claimed, as advanced above, with the exception of requiring receiving a rollover matrix indicating a number of units of call usage that are available for rolling over to a subsequent usage period; rolling over to the subsequent usage period the number of units of call usage that are available for rolling over, and showing the number of units of call usage that have been rolled over to the subsequent usage period (claim 29, lines 10-13 & 16). Cingular discloses providing a user with rollover minutes that are unused minutes that can be added to their next month's minute allotment (paragraph 6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Hanagan et al. '362, in view of Cingular, for the basic reason of allowing users to keep their unused minutes for a time when they will need them (paragraphs 6-8). Additionally, it would be obvious to one of ordinary skill in the art to display, on the users bill for example, how many minutes are leftover, since it is already standard to show the minutes used, for the basic reason of allowing users to see how many of their minutes are going to rollover into the next usage period.

Response to Arguments

Applicant's arguments filed January 20, 2009 have been fully considered but they are not persuasive.

In response to applicant's arguments, the recitation "revenue sharing between a wireless telecommunications carrier and a disparate wireline communications carrier" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts of disclosed by the examiner.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LINDSAY M. MAGUIRE whose telephone number is (571)272-6039. The examiner can normally be reached on M-F: 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-670202. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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